

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action transmitted February 3, 2009 ("*Office Action*"), the Advisory Action mailed April 16, 2009 ("*Advisory Action*"), and the Notice of Panel Decision from Pre-Appeal Brief Review mailed June 4, 2009 ("*Panel Decision*"). Claims 1-25 were pending in the Application and stand rejected. Applicant currently amends Claims 1, 9, 17 and 25 and cancels Claims 2-3, 10-11 and 18-19. These amendments are fully supported by the specification as originally filed. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

I. Rejections under 35 U.S.C. § 112

The Office Action maintains its rejection of Claims 1-25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. With respect to Claims 1, 9, 17, and 25, the *Office Action* maintains its assertion that Applicant has not defined how to determine if a provider is satisfactory or how to rank those that are satisfactory. *Office Action*, p. 3. The claim language itself, however, clearly describes how to perform these functions, reciting "determin[ing] whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements," and "ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers" (emphasis added).

The specification provides guidance beyond that provided in the claims. For example, with regard to determining whether the service provider is satisfactory, the specification recites that, by "[u]sing elements such as service registry 24, organization agent 22 can discover one or more potential services 18 for fulfilling a specified business function." P. 10. Moreover, "[o]rganization agent 22 queries the identified services regarding specific service descriptions at step 118. This permits organization agent 22 to further refine the list of potential services 18 for fulfilling the business function requirements." P. 19, ll. 22-24. With regard to ranking each of the satisfactory service providers, the specification recites that "organization agent 22 ranks the matching services 18 according to appropriate criteria at step 124. For example, in the purchasing context, organization agent 22 may arrange various product bids based upon cost, delivery time, and other suitable criteria." P. 20, ll. 2-5. Thus,

contrary to the *Office Action's* assertion, Applicant has sufficiently described how to determine if a provider is 'satisfactory' and how to rank those that are satisfactory. Accordingly, Claims 1, 9, 17, and 25 comply with the enablement requirement, and Applicant respectfully requests the Examiner to withdraw the rejection and allow these claims.

With respect to Claim 9, the *Office Action* also maintains its assertion that Applicant's disclosure does not disclose how an "agent" establishes a database. *Office Action*, p. 3. In support of maintaining its assertion, the *Office Action* explains that the portion of the specification previously cited by Applicant does not mention a database. *Office Action*, p. 4. Applicant again respectfully submits that the claim terms should take their plain, ordinary meaning, given their context in the claim language and the descriptions in the specification, as would be attributed by one of ordinary skill in the art. In context, Claim 9 recites that "an organization agent . . . establish[es] an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements" (emphasis added). As example support for this type of function, the specification recites: "organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors." P. 8, ll. 18-19. Applicant respectfully submits that one of ordinary skill in the art would be able to establish a database containing the information as specified by Applicant based on the description provided in the claims and specification. Thus, contrary to the *Office Action's* assertion, Applicant has disclosed how an "agent" establishes a database, given its context in the claim language and the descriptions in the specification.

The Examiner additionally rejects Claims 9-16 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With respect to Claim 9's "organization agent," the *Office Action* argues that the system components or structure is not claimed such that one understands the structure required to carry out these steps. *Office Action*, p. 4. Applicant respectfully submits, however, that Claims 9-16 are definite without amendment because the meaning of these claims would be clear to one of ordinary skill in the art. See M.P.E.P. § 2173.02. Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Accordingly, a term is not indefinite merely

because it lacks structural elements; rather, terms may take the plain and ordinary meanings that are consistent with the specification.

In Claim 9, the plain and ordinary meaning of the phrase “organization agent” would be clear to one of ordinary skill in the art in light of the specification. For example, Applicant’s specification recites: “Within organization 14, organization agent 22 handles this dynamic discovery and interaction by interfacing with service providers 12 and other elements of system 10. To perform organization management, organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors.” P. 8. The specification also recites: “Interface 42 provides a link between agent 40 and other entities within system 10. Depending upon the particular types of communications and configurations within system 10, interface 42 may include any suitable combination of hardware and/or logic for interacting with other components.” P. 15. Moreover, the claim language itself recites “an organization agent coupled to the service providers and the service registry using a communication network.”

Because the meaning of the phrase “organization agent” would be clear to one of ordinary skill in the art in light of the specification, Applicant submits that Claims 9-16 are, in fact, definite and comply with 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully requests the Examiner to withdraw the rejection and allow these claims.

II. Rejections under 35 U.S.C. § 101

The Examiner rejects Claims 1-16 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Under the rule recently enunciated in *In re Bilski*, an invention is patent-eligible if it (1) is tied to a particular machine or apparatus; or (2) transforms a particular article into a different state or thing. *In re Bilski*, No. 2007-1130, slip op. (Fed. Cir. October 30, 2008). Under this rule, a patent-eligible process cannot be purely a fundamental principle (law of nature, natural phenomena, or abstract idea) or a purely mental process. *Id.* at 7.

With respect to Claims 1-8, the *Office Action* argues that the claimed process does not satisfy the transformation test. *Office Action*, p. 6. Applicant respectfully disagrees. For example, Applicant’s amended Claim 1 requires “negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider” and “accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service.” These steps clearly recite

transformations. Applicant thus respectfully submits that Applicant's process is patent-eligible.

With respect to Claims 9-16, the *Office Action* argues that the claimed service providers are not patent-eligible because they encompass human beings. According to Applicant's claims and specification, however, the meaning of the phrase "service providers" does not encompass human beings. The claim language itself refutes any such interpretation, reciting "service providers each having a network address, a plurality of features providing access to a service, and a plurality of service descriptors describing the service." In addition, the specification states: "Each service provider 12 represents any suitable collection of components capable of offering access to services through defined interfaces. Service providers 12 offer machine readable interfaces that enable structured queries to access and interact with information regarding services 18." *Specification*, p. 6, ll. 14-17. Thus the phrase "service providers," as used by Applicant, does not encompass human beings. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 9-16 under § 101 and allow these claims.

III. Rejections under 35 U.S.C. § 103

A. Claims 1-7, 9-15, 17-23, and 25 are patentable over *Das* and *Vashistha*.

The Examiner rejects Claims 1-7, 9-15, 17-23, and 25 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2003/0023499 to Das, et al. ("*Das*") in view of U.S. Patent Publication No. 2001/0051913 to Vashistha, et al. ("*Vashistha*"). Applicant respectfully traverses this rejection and submits that *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest the combination of limitations recited in the claims.

Consider Applicant's independent Claim 1, as amended, which recites:

A method for automated management of business services comprising:
establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;
accessing a service registry using the business function indicator to identify a network address for each of a plurality of service providers each having a service indicator matching the business function indicator;
for each of the identified service providers:
communicating with the service provider to determine feature interfaces for interacting with the service provider;

accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider;

determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and

if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider;

ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors from each of the satisfactory service providers; and

accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service.

Among other aspects, *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest (1) “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;” and (2) “accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; . . . if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider; . . . and accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service,” as Claim 1 requires.

i. Das and Vashistha fail to teach or suggest establishing an organizational database.

Claim 1 requires “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements.” As teaching these aspects, the *Office Action* relies on *Vashistha*, paragraphs 36 and 38. In particular, the *Office Action* argues that since “buyer and supplier profiles are entered such that the outsourcing system can suitably match buyers and providers, therefore, it is obvious that a business function indicator is disclosed that enables identification of the provider.” *Office Action*, p. 6. Applicant respectfully traverses and submits that entering of buyer and supplier profiles for purposes of matching buyers and providers fails to teach or suggest “establishing an organizational database maintaining at least one business function description comprising a business function indicator and a

plurality of business function requirements,” as Claim 1 recites. Such a database is neither inherent nor suggested based on *Vashistha*’s disclosure. For at least this reason, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of the claims.

- ii. ***Das and Vashistha fail to teach or suggest accessing a first one of the feature interfaces . . . using a second one of the feature interfaces . . . and accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service.***

Claim 1, as amended, requires “accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; . . . if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider; . . . and accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service.”

As teaching the claimed service providers, the *Office Action* points to *Das*’s product vendors of ¶ 66. The *Office Action* then assumes that the claimed “feature interfaces for interacting with the service provider” must be determined because *Das* teaches that services are identified in ¶ 50. *Office Action*, p. 7. However, nothing in *Das* teaches or suggests even a single feature interface, let alone three separate feature interfaces used as required by Applicant’s claims.

Independent Claims 9, 17 and 25 include limitations that, for substantially similar reasons, are not taught by *Das* and *Vashistha*. Because *Das* and *Vashistha* do not teach or suggest every element of independent Claims 1, 9, 17 and 25, Applicant respectfully requests reconsideration and allowance of Claims 1, 9, 17 and 25 and their respective dependent claims.

B. Claims 8, 16, and 24 are patentable over *Das*, *Vashistha*, and *Chun*.

The Examiner rejects Claims 8, 16, and 24 under 35 U.S.C. §103(a) as unpatentable over *Das* in view of *Vashistha* in further view of U.S. Publication No. 2002/0184527 to Chun et al (“*Chun*”). As described above, Applicant has shown that *Das* and *Vashistha* fail to disclose all limitations of independent Claims 1, 9, and 17. Accordingly, *Das* and *Vashistha* fail to teach or suggest all limitations of Claims 8, 16, and 24 because these dependent claims

incorporate the limitations of their respective independent claims. *Chun* fails to remedy the deficiencies of *Das* and *Vashistha*.

Thus, *Das*, *Vashistha*, and *Chun*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 8, 16, and 24. Because the references fail to teach all limitations of the claims, Applicant respectfully requests reconsideration and allowance of Claims 8, 16, and 24.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of this Application.

If the Examiner feels prosecution of the present Application may be advanced by a telephone conference, Applicant invites the Examiner to contact the undersigned attorney at (214) 953-6584.

The Commissioner is hereby authorized to charge \$810.00 in payment of the fee to file a Request for Continued Examination, any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'K-M Pankratz', with a long horizontal line extending to the right.

Kurt M. Pankratz
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